

abrasive grains comprise: (A) simple particles comprising at least one member selected from the group consisting of inorganic particles and organic particles; and (B) composite particles ... the abrasive grains are employed in an amount of 0.11 to 20% by mass, a content of the simple particles (A) being from 0.1 to 19.99% by mass and a content of the composite particles (B) being from 0.01 to 19.9% by mass; and the composite particles (B) comprise the inorganic particles in an amount of from 1 to 2,000 parts by weight per 100 parts by weight of the organic particles" (emphasis added). Motonari does not disclose or suggest such a process.

As indicated above, claim 7 requires both simple particles (organic or inorganic particles) and composite particles (inorganic organic composite particles). While Motonari mentions the possibility that both simple particles and composite particles could be employed (*see, e.g., Motonari*, column 6, lines 41 to 44), there is no specific disclosure in Motonari of a polishing composition including both simple particles and composite particles. In each of the Examples of Motonari, either composite particles or simple particles are employed. *See Motonari*, Tables 1 and 2. There is no Example in Motonari where both composite particles and simple particles are employed.

Motonari plainly does not disclose employing a composition including both simple particles and composite particles, so the inquiry turns to whether Motonari suggests employing both simple particles and composite particles. Even if were possible to argue that Motonari suggests using both simple particles and composite particles (which Applicants do not admit), any *prima facie* case of obviousness is rebutted by the results shown in the present specification – "[a] *prima facie* case of obviousness ... is rebuttable by proof that the claimed compounds possess unexpectedly advantageous or superior properties." *See* MPEP §2144.09 (citing *In re Papesch*, 315 F.2d 381 (C.C.P.A. 1963)). The Examples of the present specification demonstrate that polishing with compositions including both simple particles

and composite particles provides superior performance in comparison with polishing with compositions including one or the other type of particles. In each of Examples 1 to 5 of the present specification, polishing is carried out using compositions with both simple particles and composite particles, while in Comparative Examples 1 and 2 polishing is carried out using compositions with only simple particles as in, for example, Examples 5, 6 and 8 of Motonari. *See, e.g.*, present specification, page 45, Table 1. Table 1 of the present specification shows that polishing with compositions, such as in Motonari, yields inferior results, particularly with respect to peeling and scratching. *See, e.g.*, present specification, page 45, Table 1. These results are objective evidence of the improvements of the processes of claim 7 over known polishing processes as in Motonari, and thus these results rebut any suggestion that it would have been obvious to modify the processes of Motonari to obtain the process of claim 7.

Claim 7 further requires that the simple particles and composite particles be present in particular amounts and that the composite particles have a particular composition. It is undisputed that Motonari fails to disclose or suggest these particular parameters for the simple particles and composite particles. *See* Office Action, page 4. However, the Office Action asserts that it would have been obvious to select such parameters. *See* Office Action, pages 4 to 5. As it would not have been obvious to use both simple and composite particles, as discussed above, it also would not have been obvious to select the particular amounts and compositions of particles recited in claim 7.

As Motonari fails to disclose or suggest employing abrasive particles, as recited in claim 7, Motonari fails to disclose or suggest each and every feature of claim 7.

As explained, claim 7 would not have been rendered obvious by Motonari. Claims 9, 13-15 and 18-21 depend from claim 7 and, thus, also would not have been rendered obvious

by Motonari. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

For the foregoing reasons, Applicants submit that claims 1-11, 13-15 and 18-21 are in condition for allowance. Prompt reconsideration and allowance are respectfully requested.

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